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09/719,111	12/08/2000	Yoshihito Ishibashi	450108-02586	4571
20999	7590	04/28/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			HOFFMAN, BRANDON S	
			ART UNIT	PAPER NUMBER
			2136	8

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/719,111

Applicant(s)

ISHIBASHI, YOSHIHITO

Examiner

Brandon Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 9-31 are pending in this office action, claims 1-8 are canceled.
2. Applicant's arguments filed April 2, 2004, have been fully considered but they are not persuasive.

### *Rejections*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9-12, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuzaki et al. (U.S. Patent No. 6,289,314).

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Regarding claims 9 and 27, Matsuzaki et al. teaches an information processing apparatus/method for controlling transfer of contents to a destination information processing apparatus, comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252); and
- Judgment means for judging whether transfer of said contents is possible in accordance with said usage control status (col. 19, lines 18-35);
  - Wherein said judgment means performs the judging based on ID information stored to the storage area of said destination information processing apparatus in said usage control status (col. 15, lines 50-61).

Regarding claim 10, Matsuzaki et al. teaches wherein said judgment means judges that transfer of said contents is possible when said ID information comprises the source information processing apparatus ID (fig. 6).

Regarding claims 11 and 28, Matsuzaki et al. teaches an information processing apparatus/method for canceling transfer of contents when the transfer of contents is performed to a destination information processing apparatus, comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252); and
- Judgment means for judging whether canceling transfer of said contents is possible in accordance with said usage control status (col. 7, lines 28-35);

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- o Wherein said judgment means performs the judging based on ID information stored to the storage area of said destination information processing apparatus in said usage control status (col. 15, lines 50-61).

Regarding claim 12, Matsuzaki et al. teaches wherein said judgment means judges that canceling transfer of said contents is possible when said ID information comprises destination information processing apparatus ID (fig. 6).

***Claim Rejections - 35 USC § 103***

6. Claims 13-18 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (USPN '314).

Regarding claim 13, Matsuzaki et al. teaches all the limitations of claim 11, above. However, Matsuzaki et al. does not teach wherein said judgment means judges whether canceling transfer of said contents is possible when ID information further stored to the storage area of the source information processing apparatus in said usage control status comprises the source information processing apparatus ID.

The Examiner takes Official Notice that wherein said judgment means judges whether canceling transfer of said contents is possible when ID information further stored to the storage area of the source information

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processing apparatus in said usage control status comprises the source information processing apparatus ID would have been an obvious modification.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine judging based on ID information stored to the storage area of said source information processing apparatus, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine judging based on ID information stored to the storage area of said source information processing apparatus ID, to the method/apparatus of Matsuzaki et al. because storing the ID information of the source information processing apparatus in the storage of the source information processing apparatus signifies transferring content to itself. This translates into canceling transferring to the destination information processing apparatus.

Regarding claims 14 and 29, Matsuzaki et al. teaches an information processing apparatus/method for canceling transfer of contents when the transfer of contents is performed to a destination information processing apparatus, comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252); and
- Judgment means for judging whether canceling transfer of said contents is possible in accordance with said usage control status (col. 7, lines 28-35).

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Matsuzaki et al. does not teach wherein said judgment means performs the judging based on ID information stored to the storage area of said source information processing apparatus in said usage control status.

The Examiner takes Official Notice that wherein said judgment means performs the judging based on ID information stored to the storage area of said source information processing apparatus in said usage control status would have been an obvious modification.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine judging based on ID information stored to the storage area of said source information processing apparatus, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine judging based on ID information stored to the storage area of said source information processing apparatus, to the method/apparatus of Matsuzaki et al. because storing the ID information of the source information processing apparatus in the storage of the source information processing apparatus signifies transferring content to itself. This translates into canceling transferring to the destination information processing apparatus.

Regarding claim 15, Matsuzaki et al. as modified teaches wherein said judgment means judges that canceling transfer of said contents is possible when

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said ID information comprises the source information processing apparatus ID (fig. 6, the modified Matsuzaki et al. shows source ID as well as destination ID.

Regarding claim 16, Matsuzaki et al. as modified teaches wherein said judgment means judges whether canceling transfer of said contents is possible when ID information further stored to the storage area of the destination information processing apparatus in said usage control status comprises the destination information processing apparatus ID (fig. 6).

Regarding claim 17, Matsuzaki et al. teaches and information processing system for canceling transfer of contents when transfer of contents is performed from a first information processing apparatus to a second information processing apparatus; said first information processing apparatus comprising:

- First storage means for storing a first usage control status (fig. 3, ref. num 252); and
- First judgment means for judging whether canceling transfer of said contents is possible based on said first usage control status (col. 7, lines 28-35);
- Wherein said second information processing apparatus comprises:
- Second storage means for storing a second usage control status (fig. 10, two receiving stations); and



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- Second judgment means for judging whether canceling transfer of said contents is possible based on said second usage control status (fig. 10, two receiving stations);
  - Wherein transfer of said contents is canceled based on the result of said first judgment means and said second judgment means (col. 15, lines 50-61, two receiving stations).

Matsuzaki et al. does not teach wherein transfer of said contents is canceled based on the result of said first judgment means and said second judgment means.

The Examiner takes Official Notice that wherein transfer of said contents is canceled based on the result of said first judgment means and said second judgment means would have been obvious.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine transfer of said contents is canceled based on the result of said first judgment means and said second judgment means, to the system of Matsuzaki et al. It would have been obvious to combine transfer of said contents is canceled based on the result of said first judgment means and said second judgment means to the system of Matsuzaki et al. because consent by both information processing apparatuses to cancel transfer of content provides acknowledgment that each apparatus agreed upon cancellation.

Regarding claim 18, Matsuzaki et al. as modified teaches wherein it is judged that canceling transfer of said contents is possible when ID information stored to the storage area of said destination information processing apparatus in first and second usage control status comprises the first information processing apparatus ID (col. 15, lines 50-61) and ID information stored to the storage area of said first information processing apparatus in first and second usage control status comprises the second information processing apparatus ID (col. 15, lines 50-61).

Claims 19-24, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (USPN '314) in view of Christiano (U.S. Patent No. 5,671,412).

Regarding claims 19 and 30, Matsuzaki et al. teaches an information processing apparatus/method for controlling transfer of contents to a destination information processing apparatus, comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252);
- Judgment means for judging whether transfer of said contents is possible in accordance with said usage control status (col. 19, lines 18-35).

Matsuzaki et al. does not teach change means for changing said usage control status based on the result of said judgment means; wherein when said judgment means judges that transfer of said contents is possible, said change means changes ID information stored to the storage area of said destination

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information processing apparatus in said usage control status into the destination information processing apparatus ID.

Christiano teaches:

- Change means for changing said usage control status based on the result of said judgment means (fig. 10, ref. num 200 and col. 19, lines 18-35);
  - Wherein when said judgment means judges that transfer of said contents is possible, said change means changes ID information stored to the storage area of said destination information processing apparatus in said usage control status into the destination information processing apparatus ID (col. 21, lines 53-61).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine change means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine change means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. because the change means correctly controls the distribution of software to a certain number of computers (1 or more) and only allows that number of computers to use the software until one of those computer systems releases its use of the software so another computer may access the software (see col. 7, lines 1-12 of Christiano).

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Regarding claim 20, the combination of Matsuzaki et al. in view of Christiano teaches wherein said information processing apparatus further comprises a transmitting means, and said transmitting means transmits the changed usage control status to said destination information processing apparatus (see fig. 10, ref. num 198 and col. 21, lines 49-53 of Christiano).

Regarding claim 21, Matsuzaki et al. teaches an information processing system for controlling transfer of contents when the transfer of contents is performed from a first information processing apparatus to a second information processing apparatus, said first information processing apparatus comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252);
- Judgment means for judging whether transfer of said contents is possible based on said usage control status (col. 19, lines 18-35);
- Wherein said second information processing apparatus comprises:
- Receiving means for receiving said usage control status transmitted by said transmitting means (fig. 2, ref. num 32);

Matsuzaki et al. does not teach change means for changing said usage control status based on the result of said judgment means; and transmitting means for transmitting the usage control status changed by said change means to said second information processing apparatus; wherein said change means changes ID information stored to the storage area of said destination information

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processing apparatus in said usage control status into the second information processing apparatus ID.

Christiano teaches:

- Change means for changing said usage control status based on the result of said judgment means (fig. 10, ref. num 200 and col. 19, lines 18-35); and
- Transmitting means for transmitting the usage control status changed by said change means to said second information processing apparatus (fig. 10, ref. num 198 and col. 21, lines 49-53);
  - Wherein when said judgment means judges that transfer of said contents is possible, said change means changes ID information stored to the storage area of said destination information processing apparatus in said usage control status into the second information processing apparatus ID (col. 21, lines 53-61).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine change means, and transmitting means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine change means and transmitting means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. because the change means and transmitting means correctly controls the distribution of software to a certain number of computers (1 or more) and only allows that number of computers to use the software until one of those computer systems release its

use of the software so another computer may access the software (see col. 7, lines 1-12 of Christiano).

Regarding claim 22, the combination of Matsuzaki et al. in view of Christiano teaches wherein said second information processing apparatus further comprises generation means, said generation means for generating the new usage control status for using said second information processing apparatus based on said usage control status received by said receiving means (see fig. 10, ref. num 25' of Matsuzaki et al., the second receiving device contains similar structure, therefore having the terminal managing portion that generates and stores usage control information).

Regarding claim 23, the combination of Matsuzaki et al. in view of Christiano teaches wherein said second information processing apparatus further comprises generation means, said generation means for generating the new usage control status for using a third information processing apparatus based on said usage control status change means transmitted by said transmitted means (see fig. 10, ref. num 25' of Matsuzaki et al., there can be more than two receiving devices as shown in col. 25, lines 51-61 of Matsuzaki et al.).

Regarding claims 24 and 31, Matsuzaki et al. teaches an information processing apparatus/method for canceling transfer of contents when the transfer

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of contents is performed from a first information processing apparatus to a second information processing apparatus, comprising:

- Storage means for storing a usage control status (fig. 3, ref. num 252);
- Judgment means for judging whether canceling transfer of said contents is possible based on said usage control status (col. 7, lines 28-35).

Matsuzaki et al. does not teach change means for changing said usage control status based on the result of said judgment means; wherein when said judgment means judges that transfer of said contents is possible, said change means changes ID information stored to the storage area of said destination information processing apparatus in said usage control status into the source information processing apparatus ID or initial value.

Christiano teaches:

- Change means for changing said usage control status based on the result of said judgment means (fig. 10, ref. num 200 and col. 19, lines 18-35);
- Wherein when said judgment means judges that transfer of said contents is possible, said change means changes ID information stored to the storage area of said destination information processing apparatus in said usage control status into the source information processing apparatus ID or initial value (col. 21, lines 53-61).

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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine change means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine change means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. because the change means correctly controls the distribution of software to a certain number of computers (1 or more) and only allows that number of computers to use the software until one of those computer systems releases its use of the software so another computer may access the software (see col. 7, lines 1-12 of Christiano).

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (USPN '314) in view of Christiano (USPN '412), and further in view of Shimakawa et al. (U.S. Patent No. 6,502,124).

Regarding claim 25, Matsuzaki et al. teaches an information processing system for canceling transfer of contents when the transfer of contents is performed from a first equipment information processing apparatus to a second information processing apparatus; said first information processing apparatus comprising:

- First storage means for storing a first usage control status (fig. 3, ref. num 252);
- Judgment means for judging whether canceling transfer of said contents is possible based on said first usage control status (col. 7, lines 28-35);



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- Said second information processing apparatus comprising:
- Second storage means for storing a second usage control status (fig. 10, two receiving stations);
- Receiving means for receiving said transfer cancel command (fig. 2, ref. num 32).

Matsuzaki et al. does not teach change means for changing said usage control status based on the result of said judgment means; and transmitting means for transmitting a transfer cancel command to said second information processing apparatus.

Christiano teaches:

- Change means for changing said usage control status based on the result of said judgment means (fig. 10, ref. num 200 and col. 21, lines 53-61); and
- Transmitting means for transmitting a transfer cancel command to said second information processing apparatus (fig. 10, ref. num 198 and col. 21, lines 49-53);
  - Wherein when said judgment means judges that canceling transfer of said contents is possible, said change means changes ID information stored to the storage area of said second information processing apparatus in said first usage control status into the first information processing apparatus ID or initial value (col. 21, lines 53-61).

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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine change means, and transmitting means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. It would have been obvious to combine change means and transmitting means, as taught by Christiano, to the method/apparatus of Matsuzaki et al. because the change means and transmitting means correctly controls the distribution of software to a certain number of computers (1 or more) and only allows that number of computers to use the software until one of those computer systems release its use of the software so another computer may access the software (see col. 7, lines 1-12 of Christiano).

Matsuzaki et al. as modified by Christiano still does not teach deletion means for deleting said second usage control status; wherein said deletion means deletes said second usage control status when said receiving means receives said transfer cancel command.

Shimakawa et al. teaches:

- Deletion means for deleting said second usage control status (col. 14, lines 25-27); wherein said deletion means deletes said second usage control status when said receiving means receives said transfer cancel command.

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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine deletion means, as taught by Shimakawa et al., to the system of Matsuzaki et al. as modified. It would have been obvious to combine deletion means, as taught by Shimakawa et al., to the system of Matsuzaki et al. as modified because the deletion means informs the information processing apparatus that the license has been released and a different information processing apparatus can then use the license.

Regarding claim 26, the combination of Matsuzaki et al./Christiano/Shimakawa et al. teaches wherein said second information processing apparatus further comprises reply means, said reply means replaying a signal indicative of said first information processing apparatus, after said deletion means deleted said second usage control status, and wherein said change means changes said first usage control status after receiving said completion signal of deletion (see col. 21, lines 61-67 of Christiano and col. 14, lines 28-30 of Shimakawa et al.).

### ***Response to Arguments***

7. Applicant cancels claims 1-8, and adds claims 9-31.
8. Applicant argues canceling the claims previously rejected to by the Examiner, while adding new claims that show features not addressed by the prior rejection, place the application in a condition for allowance (page 13, last paragraph).

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Regarding argument (a), examiner disagrees with applicant. While it is true that the new claims have limitations that were not addressed by the first rejection, the new grounds of rejection, as necessitated by the amendment, teach the limitations of the newly added claims. Therefore, applicants' arguments for the first set of claims are moot.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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